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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,787	12/13/2000	Mark A. Ritchart	END-712	6087

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,787

Applicant(s)

Ritchart et al.

Examiner

Max Hindenburg

Art Unit

3736



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 16, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-34 is/are pending in the application.
- 4a) Of the above, claim(s) 23-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: : 3736

1. Claims 15, 16 and 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 15, 16 and 18-22 are indefinite in that they do not further limit the method claims from which they depend in that they set forth no further limiting steps of the method of extracting a tissue sample.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11, 14, 17-19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schramm et al. '101 in view of Silverman.

Schramm et al. '101 teach a biopsy instrument as claimed by applicant including an outer hollow cannula having a distal end portion capable of piercing and cutting tissue propelled by a first spring and an inner member with a distal end capable of both cutting and severing tissue propelled by a second spring, wherein the hollow cannula and inner member are slidable with respect to each other to cut and sever a tissue sample. Schramm et al. '101 does not teach the inner member distal end being biased to expand radially to capture tissue.

Silverman teaches a biopsy instrument having an inner member having a distal portion which is biased to expand radially at its distal end. It would have been obvious to one of ordinary skill in

Art Unit: : 3736

the art, in view of Silverman, to use such a radially expanding distal end for the distal end of the inner member of Schramm et al. '101 to capture a longer piece of tissue. The method for extracting a tissue sample is also met by the combination of Schramm et al. '101 and Silverman in that the instrument is inserted in to the tissue to be sampled, the first spring is actuated to move the inner member forward expanding the distal end and capturing tissue, the second spring is actuated to move the outer cannula over the inner member radially retracting the distal end and cutting the tissue sample and then withdrawing the instrument with the tissue sample. The distal end of Silverman's inner member are considered to be jaws.

4. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schramm et al. '101 in view of Silverman and further in view of Springer. Schramm et al. '101 and Silverman are discussed above. Springer teaches a biopsy instrument having an inner member with it's distal end in the shape of an alligator tip with a pair of hinged jaws. It would have been obvious to one of ordinary skill in the art, in view of Springer, to use such an alligator tip at the distal end of the inner member of Schramm et al. '101 to grasp and cut the tissue. The method of extracting a tissue sample would have been obvious in view of the combination above.

5. Claims 13, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schramm et al. '101 in view of Silverman and further in view of Reznick et al. Schramm et al. '101 and Silverman are discussed above. Reznick et al. teach a biopsy instrument having an inner member with it's distal end in the shape of a plurality of hooked extractors. It would have been

Art Unit: : 3736


obvious, in view of Reznick et al., to use such a plurality of hooked extractors at the distal end of the inner member of Schramm et al. '101 to grasp and cut tissue.

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The examiner notes the distal end of the inner member of a biopsy instrument being radially expandable in the form of a pair of jaws or a plurality of hooked extractors are well known in the biopsy art and function just as well as an inner member with a notch cut in its side for cutting and collecting a tissue sample.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Hindenburg whose telephone number is (703)308-3130.

MH

January 31, 2003


MAX F. HINDENBURG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700